

Application Serial No.: 10/772,485  
Applicant: Thomas A. Jesko  
Response Filed: January 3, 2006  
Response to Office Action Dated: September 2, 2005

### III. REMARKS

United States Serial No. 10/772,485 was filed on February 5, 2004. Claims 1, 16 and 31-47 have been amended. In view of the remarks set forth herein, Applicant respectfully requests reconsideration of claims 1-47.

#### Claim Objections

Claims 1-47 have been objected to for use of the term "a gap" throughout the claims. It is specifically alleged that it is not clear from the claims if the "gap" that is continuously mentioned is the same "gap" or a different "gap." This objection applies to independent claims 1, 16, and 31.

Claim 1 has been amended to read as follows:

"A cover assembly for a gap between two structural members comprising:

an elongated resilient cover having a load bearing surface opposite a support surface including marginal support areas along opposite lateral edges thereof, said cover having a thickness and sufficient elasticity to elastically deform for establishing supporting contact between said marginal support areas and underlying horizontal structural members adjacent to *said gap* between said horizontal structural members and a width sufficient to overlie portions of said horizontal structural members outwardly of said gap;

a rigid plate member secured by and encapsulated within said elongated resilient cover for bridging *said gap* between said horizontal structural members; and

a plurality of fasteners engaged with said cover at spaced apart sites along at least one lateral side portion of said cover for elastically anchoring said elongated resilient cover to at least one of said horizontal structural members."

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Claim 16 has been amended to read as follows:

"A cover assembly for a gap between horizontal structural members comprising:  
an elongated resilient cover having a predetermined width sufficient to overlie portions of horizontal structural members outwardly of marginal edges to *said gap* between the horizontal structural members and a width sufficient to overlie portions of said horizontal structural members outwardly of said gap;  
a rigid plate member secured by and encapsulated within said elongated resilient cover, said rigid plate member defining an elongated bridging member having a width sufficient to span the width of *said gap* between horizontal structural members while secured thereby; and  
a plurality of fasteners to anchor said resilient cover along at least one marginal edge of said resilient cover to at least one of said horizontal structural members."

Claim 31 has been amended to read as follows:

"An expansion joint for a building structure comprising:  
two spaced structural members defining a gap therebetween; and  
a cover assembly comprising an elongated resilient cover having a load bearing surface opposite a support surface including marginal support areas along opposite lateral edges thereof, said cover having a thickness and sufficient elasticity to elastically deform for establishing supporting contact between said marginal support areas and underlying horizontal structural members adjacent an expansion joint and a width sufficient to overlie portions of said horizontal structural members outwardly of *said gap*;  
a rigid plate member secured by and encapsulated within said elongated resilient cover for bridging a joint formed in *said gap* between said horizontal structural members; and  
a plurality of fasteners engaged with said cover at spaced apart sites along at least one lateral side portion of said resilient cover to elastically anchor said elongated resilient cover to at least one of the horizontal structural members."

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Claim 46 has been amended to read as follows:

"A method for the installation of a cover assembly across a gap between two structural members comprising:

providing a cover assembly comprising an elongated resilient cover having a load bearing surface opposite a support surface including marginal support areas along opposite lateral edges thereof, said cover having a thickness and sufficient elasticity to elastically deform for establishing supporting contact between said marginal support areas and underlying horizontal structural members and a width sufficient to overlie portions of said horizontal structural members outwardly of *said gap*;

a rigid plate member secured by and encapsulated within said elongated resilient cover for bridging *said gap* between said horizontal structural members; and

a plurality of fasteners engaged with said cover at spaced apart sites along at least one lateral side portion of said resilient cover to elastically anchor said elongated resilient cover to at least one of the horizontal structural members; and

placing said cover assembly across *said gap*.

Applicant respectfully submits that the amendments to claims 1, 16, 31, 46 and 47 are sufficient to overcome the present objections. Applicant, therefore, respectfully requests withdrawal of the objections to claims 1-47.

Claim 47 has been objected to under 37 C.F.R. §1.75(c), as being an improper dependent claim for failing to further limit the subject matter of a previous claim.

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Claim 47 has been amended to read as follows:

"The method of claim 46, wherein the method comprises ***providing*** at least two rigid plate members encapsulated by said elongated resilient cover to extend along opposite lateral sides of said rigid plate member for ***allowing*** elastic deformation of said cover and for ***applying*** a biasing force in a direction to urge opposite lateral sides of said cover toward the horizontal structural members while resiliently deformed by traffic traversing said traffic bearing surface."

Other Claim Amendments:

Independent claim 31 is directed to an expansion joint system. The preamble of dependent claims 32-45 have been amended to refer to an expansion joint system. Applicant submits that this is merely a correction of a minor typographical error, and does not involve the addition of new matter.

**35 U.S.C. §102(b)**

Claims 1, 3, 5, 6, 8, 9, 11, 13, 14, 31, 33, 35, 36, 38, 39, 46 and 47 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,758,220 ("Hein"). In reference to claims 1 and 31, it is alleged that Hein discloses an elongated resilient cover (10, 20) having a load bearing surface (LB) opposite a supporting surface (SS), a rigid plate (21) encapsulated therein, and a plurality of fasteners (8) engaging the cover (10, 20) at spaced apart locations along the lateral sides thereof to thereby secure the cover. It is further alleged that the cover has a thickness sufficient to elastically deform by bending/flexing the cover.

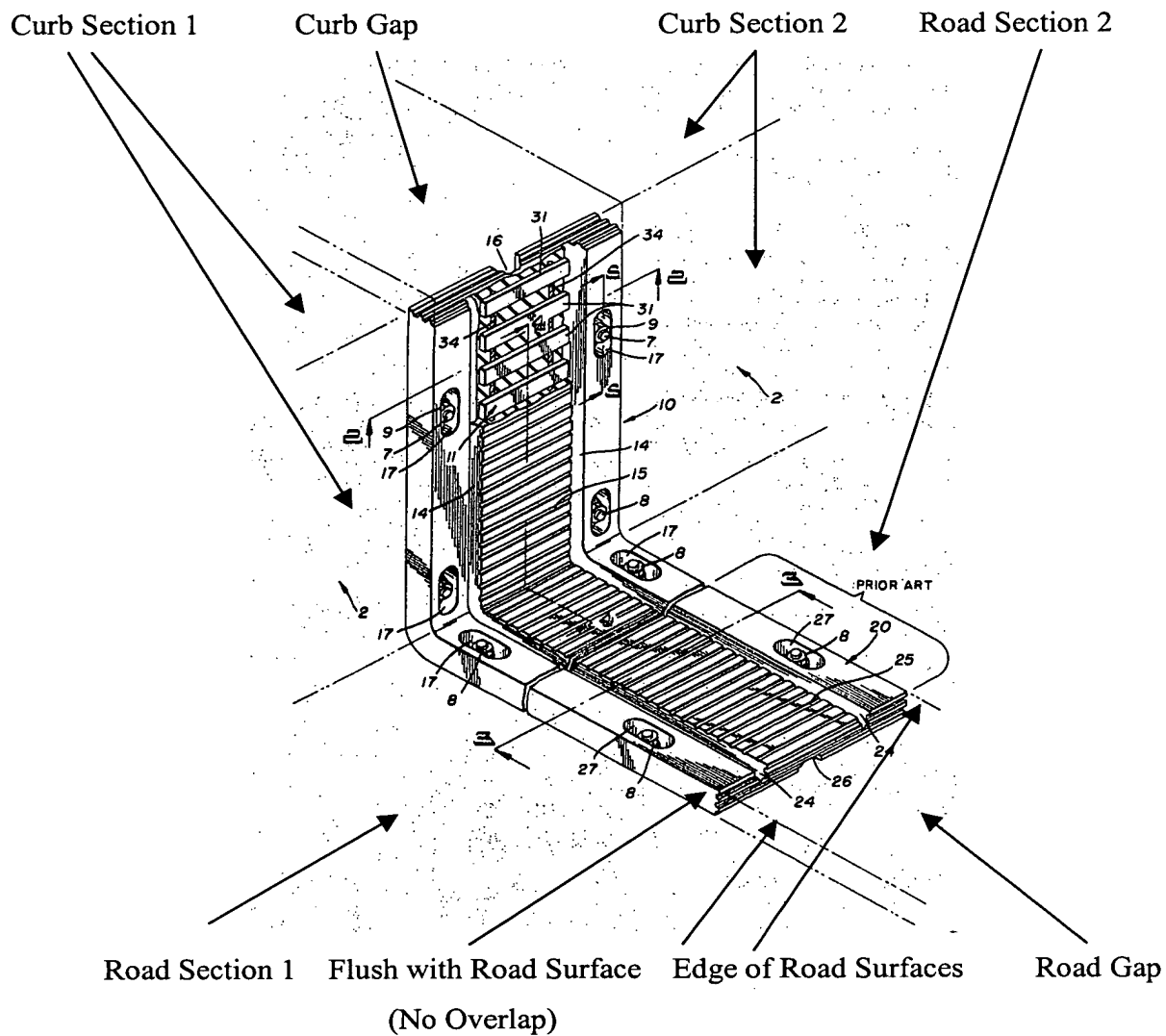
Applicant respectfully traverses this rejection. To establish anticipation of a claim, each and every element as set forth in the claim must be found, either expressly or inherently described, in the single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Hein does not

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disclose a cover assembly to overlie a gap between two structural members. To the contrary, the system of Hein is installed completely within the gap between the two spaced apart structural members. In describing conventional joint assemblies, to which the Hein joint assembly is connected, Hein discloses that shoulders are usually provided on the adjacent roadway sections to anchor the joint edges. The joints are fabricated "[s]o that when supported on the shoulders, the top surface of the joint is substantially flush with the top surface of the roadway." Column 1, lines 35-38.

Figure 1 of Hein clearly demonstrates the installation of the joint assembly (10) with a conventional joint (20) completely within the gap between the curb and road sections. "Each section 10 and 20 are provided with similar lateral recesses 17 and 27 respectively for receiving suitable means 8 for anchoring each joint **between the adjacent roadway sections.**" Column 4 lines 6-10. The road surface edges are indicated in the original Figure 1 by the dashed lines. As displayed, the joint assembly is installed between the road sections with the surface of the joint assembly being flush with the top surface of the road. The joint assembly disclosed by Hein does not overlie any portion of the top surface of the road sections. The distinction between the Hein invention and the present invention is highlighted in the annotated Hein FIG. 1 on the following page of this Response.

**HEIN FIG. 1**



In stark contrast to Hein, the present application claims a cover assembly for a gap between structural members, which is installed over the gap and extends to overlies portions of the structural members outwardly of the gap. See Figs. 1 and 3. Unlike Hein, the cover assembly is not flush with the top surface of the structural members (10, 12), but it actually overlies the top surfaces of the structural members (10, 12).

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Additionally, Hein does not disclose an elongated resilient cover with a thickness sufficient to elastically deform the cover by bending/flexing of the cover. The Examiner points to Figures 1 and 4, and column 4, lines 11-39 of Hein to support this allegation. Those examples describe a joint section "bent or flexed vertically upwardly as might be required to span an expansion gap at the gutter and curb section of a roadway." The ability to bend the joint is not attributable to having a thickness and elasticity to elastically deform. In the section referred to by the Examiner, Hein requires connecting the embedded plates with "relatively flexible" metal cables. Hein Column 4, lines 30-35. The cables allow the joint to be bent "[t]o conform to peculiar curb sections." Hein Column 4, lines 35-39.

In fact, the joint assembly disclosed by Hein specifically resists deformation from traffic. The Hein joint "can be selectively bent or flexed to conform to curbs and/or gutter areas which will not bulge when contracted and which provides sufficient stiffening to resist bending moments over any vehicular traffic passing across the joint." Hein Column 2, lines 55-62.

As this limitation of independent claims 1, 31 and 46 is not disclosed by Hein, anticipation cannot apply. Claims 3, 5, 6, 8, 9, 11, 13 and 14 ultimately depend from claim 1. Claims 33, 35, 36, 38, and 39 ultimately depend from claim 31. Claim 47 depends from claim 46. As a matter of law, a dependent claim cannot be anticipated if the independent claim from which it depends is not anticipated.

#### Welch

Claims 16, 18, 20, 23, 24, 46 and 47 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,862,810 ("Welch"). It is specifically alleged that Welch discloses an elongated resilient cover (10), a rigid plate (18, 26, 32) encapsulated therein each having a predetermined width sufficient to overlies portions of horizontal members outwardly of marginal areas of a gap therebetween, and a plurality of fasteners

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engaging the cover (10) at spaced apart locations along the lateral sides thereof to thereby secure the cover (10).

Applicant respectfully traverses this rejection. As with Hein, the expansion joint system of Welch is installed entirely in a gap between the two spaced apart road sections. Welch expressly discloses a joint seal that maintains "[a] substantially smooth and level surface between adjacent deck sections." Column 2 lines 31-34. Welch teaches that the joint seals are to be mounted on shoulder sections. "Usually, the vertically recessed horizontal shoulders are provided in the adjacent roadway sections and the edges of the expansion joint are anchored to such shoulders within the recess formed in a manner **whereby the top surface of the expansion joint is substantially flush with the surface of each adjacent section.**" Column 1, lines 42-48. The vertical sides of the expansion joint assembly are installed adjacent to the vertical walls of the opposing curb and road sections. "As the sections of the bridge deck expand or contract, ... the shoulders and studs exert a compressive force against the sides of the expansion joint." Column 3, lines 39-43. Therefore, the joint seal disclosed by Welch does not cover any portion of the traffic bearing surface of the spaced apart adjacent road surfaces.

In contrast to Welch, the resilient cover of the cover assembly is installed across a gap, not within the gap. The resilient cover is not flush with the top surface of the structural members (10, 12), but actually overlies portions of the structural members (10, 12). Independent claim 16 claims a cover having a width sufficient to overlie portions of the opposing structural members. Welch does not disclose this limitation and, therefore, anticipation cannot apply. Accordingly, independent claim 16 is allowable over the Welch reference. Claims 18, 20, 23 and 24 ultimately depend from independent claim 16 and as a matter of law are not anticipated by the Welch reference.

Regarding claims 46 and 47, it is specifically alleged that Welch discloses the method of installing the "cover assembly" including the steps of providing the cover, establishing supporting contact, and placing the cover across the gap. Regarding claim 47, it is alleged



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that Welch discloses inherently applying a biasing force in a direction to urge the lateral sides downward towards an underlying horizontal surface while deforming the traffic traversing load bearing surface.

Applicant respectfully traverses the rejection of claims 46 and 47. Applicant has distinguished the cover assembly of the present invention from the joint seal assembly of Welch, in connection with the rejection of independent claim 16. The distinctions between the Welch reference and the cover assembly of the present invention, which are set forth above, apply equally to the rejection to claims 46 and 47. The joint seal of Welch does not overlie portions of horizontal surfaces of the road sections, and the Welch joint assembly does not deform with traffic. To the contrary, Welch discloses that the joint assembly has "grooves or spaces to permit relative horizontal movement between the members **without compressive deformation of the support bodies.**" Column 2, lines 58-60.

Therefore, Welch does not disclose a method of placing a cover over a gap, applying a biasing force towards an underlying horizontal surface, or being resiliently deformed by traffic traversing the traffic bearing surface. Applicant therefore respectfully submits that claims 46 and 47 are allowable over Welch.

In view of the above remarks, Applicant respectfully requests withdrawal of the 35 U.S.C. §102(b) rejections.

### **35 U.S.C. §103 Rejection**

Claims 2, 4, 5, 7, 10, 12, 15, 32, 34, 35, 37 and 40-45 have been rejected under 35 U.S.C. §103(a) as being obvious over Hein. Claims 17, 19 and 25-28 have been rejected under 35 U.S.C. §103(a) as being obvious over Welch. Finally, claims 21, 22, 29 and 30 have been rejected under 35 U.S.C. §103(a) as being anticipated by Welch in view of Hein or U.S. Patent No. 3,363,522 ("Galbreath").

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To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983). Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

#### Hein

It is specifically alleged that Hein discloses the basic claimed cover assembly, except for the cover having tapered lateral sides, for fasteners being screws, nails, or rivets, and the elastomeric material being ethylene-propylene-diene rubber.

Applicant respectfully traverses this rejection. Hein does not teach or suggest all the claim limitations. With reference to claims 2, 10, 32 and 40, the Office Action concedes that Hein does not disclose a cover having tapered lateral sides. Notwithstanding, it is alleged that it would have been obvious to one having ordinary skill in the art to provide the cover of Hein with tapered lateral side edges, as tapers are known for allowing items to be easily wedged.

To begin, the cover assembly of the present invention is not "wedged" in the gap between the structural members. Rather, the cover assembly overlies the gap and portion of the structural members outwardly of the gap. As Hein does not disclose or suggest a cover assembly that overlies portions of horizontal structural members outwardly of a gap between the two structures, a *prima facie* case of obviousness has not been established.

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Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). The joint assembly of Hein is designed to be installed flush with the top surface of the road sections. If Hein joint assembly was modified to include tapers and the modified joint assembly was positioned entirely within the gap as required by Hein, then the tapered edges would leave gaps between the edges of the spaced apart structural members and the modified joint assembly. This would cause a potential hazard for pedestrian and vehicular traffic traversing the modified joint assembly. The proposed modification to Hein clearly changes the principle of operation of the Hein invention and, therefore, this proposed modification to Hein is not sufficient to render the present claims *prima facie* obvious.

As detailed above, the joint assembly of Hein also requires the joint seal to resist traffic deformation, whereas the presently claimed resilient cover that will deform in response to traffic. The proposed modification would require a substantial reconstruction and redesign of the joint assembly of Hein to permit deformation of the joint seal. Therefore, the teachings of the reference are not sufficient to render the claims *prima facie* obvious.

With reference to claims 4, 12, 34 and 42, it is alleged that it would have been obvious to one having ordinary skill in the art to select screws, nails and rivets as the fasteners. Nevertheless, Hein still does not disclose or suggest the use of fasteners in connection with a resilient cover having a sufficient width to span a gap and overlie portions of structural members outwardly of the gap.

With reference to claims 7, 15, 37 and 45, the Office Action concedes that ethylene-propylene-diene rubber is not disclosed, but that it would have been obvious to one having ordinary skill in the art to select a known material based on its suitability for the intended use. Hein, however, does not disclose, suggest, or provide motivation for a resilient cover made

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from ethylene-propylene-diene rubber which overlies portions of spaced apart structural members outwardly of a gap between the structural members.

With reference to claims 5, 35, 43 and 44, it is alleged that the cover is made from an elastomeric material while Hein discloses an elastomeric material. Hein provides no disclosure or suggestion that the elastomeric cover overlies a gap and portions of structural members outwardly of the gap.

In view of the above remarks, Applicant respectfully submits that claims 2, 4, 5, 7, 10, 12, 15, 32, 34, 35, 37 and 40-45 are not rendered obvious by Hein. Therefore, Applicant respectfully request that the rejection under 35 U.S.C. 103 be withdrawn.

#### Welch

With respect to claims 17, 19 and 25-28, it is specifically alleged that Welch discloses the basic claimed cover assembly, except for the cover having tapered lateral sides, the fasteners explicitly being screws, nails, or rivets, and the elastomeric material being ethylene-propylene-diene rubber.

Applicant respectfully traverses this rejection. The joint assembly of Welch is installed entirely within a gap and flush with the top surface of opposing road sections. Welch does not disclose or suggest the use of fasteners in connection with a resilient cover having a sufficient width to span a gap and overlie portions of structural members outwardly of the gap. If the joint seal of Welch was used as a cover assembly it would not allow for a smooth transition across the road sections, thereby changing the basic principle under which the joint assembly was designed to operate.

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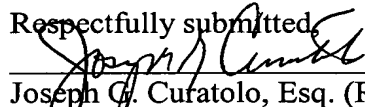
Welch in view of Hein or Galbreath

With respect to claims 21, 22, 29 and 30, it is specifically alleged that Welch discloses the basic claimed cover assembly, except for detailing the use of ethylene-propylene rubber. It is also alleged that both Hein and Galbreath teach that it is known in the art to form a cover assembly from ethylene-propylene rubber. Therefore, it is alleged that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the cover assembly of Welch out of the materials taught by either Hein or Galbreath in order to form a cover that is resilient, capable of carrying a load thereon, and that is non-corrosive.

Applicant respectfully traverses this rejection. As described above, Hein and Welch are limited to joint seal assemblies that are installed entirely within a gap between two road sections. Likewise, Galbreath discloses a joint assembly to be **"joined between adjacent sections comprising the deck of a bridge to permit expansion and contraction of the sections while maintaining a relatively smooth uninterrupted road surface."** Column 1, lines 22-27. Accordingly, the proposed combination of Welch and Hein or Welch and Galbreath does not result in a cover assembly having a resilient cover that overlies portions spaced apart structural members outwardly of a gap. Therefore, claims 21, 22, 29 and 30 are not rendered obvious by the cited art.

In view of the above remarks, Applicant respectfully requests that the rejections under 35 U.S.C. §§102 and 103 be withdrawn and that the Examiner issue a formal notice of allowability directed to claims 1-47. Should the Examiner have any questions, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

  
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